

REMARKS / ARGUMENTS

The present application includes pending claims 1-28. Claims 27 and 28 were allowed, and claims 1-7 and 12-26 were rejected. Claims 8-11 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. New claims 29-30 have been entered. The Applicant has cancelled claims 8-11. The Applicant respectfully submits that the claims define patentable subject matter.

Initially, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicant assumes, based on the goals of patent examination noted above, that

the present Office Action has set forth "all reasons and bases" for rejecting the claims.

Claims 1-2, 5-7, 13-14 and 17-26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0141441, issued to Neumann, et al. (hereinafter, Neumann). Claims 3-4, 12 and 15-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Neumann, in view of U.S. Patent Application Publication No. 2003/0067894, issued to Schmidt (hereinafter, Schmidt). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

REJECTION UNDER 35 U.S.C. § 102

I. Neumann Does Not Anticipate Claims 1-2, 5-7, 13-14 and 17-26

The Applicant first turns to the rejection of claims 1-2, 5-7, 13-14 and 17-26 under 35 U.S.C. 102(e) as being anticipated by Neumann. With regard to the anticipation rejections under 102(b), MPEP 2131 states that "[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted).

Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See id. (internal citation omitted).

A. Rejection of Independent Claim 1 under 35 U.S.C. § 102(e)

1. Rejection Based on Inherency

With regard to the rejection of independent claim 1 under 102(e), the Applicant submits that Neumann does not disclose or suggest at least the limitation of "a first baseband co-processor configured to execute low-level stack operations of a first wireless communications protocol employed within a first wireless communications network," as recited by the Applicant in independent claim 1. The Office Action states the following:

Neumann discloses a multi-mode wireless communication device (abstract, and paragraph 0004, "dual mode", telephone have been developed, in which the telephone is useable in two networks),

comprising a first baseband co-processor configured to execute low-level stack operations of a first wireless communications protocol employed within a first wireless communications network (figures 2-8B, paragraphs 6, 0019-0021, "slave baseband co-processor ... to provide baseband functions according to a second telecommunications standard", note that **the base band functions inherently include function in the physical layer**);

See the Office Action at page 2. Initially, regardless of whether this statement is true or not, the Applicant notes that it appears that claim 1 is being

rejected at least partially based on inherency. In addition, the Office Action uses similar inherency statements with regard to the rejections of claims 13, 19 and 23.

The Applicant submits that **a rejection based on inherency must include a statement of the rationale or evidence tending to show inherency.** See Manual of Patent Examining Procedure at § 2112. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." See *id. citing In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. **Inherency, however, may not be established by probabilities or possibilities.** The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The Applicant respectfully submits that neither the Neumann reference nor the Office Action "make[s] clear that the missing descriptive matter," said to be inherent "is necessarily present in" Neumann.

A rejection based on inherency must be based on factual or technical reasoning:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the

allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Applicant respectfully submits that the Office Action does not contain a basis in fact and/or technical reasoning to support the rejection based on inherency. Instead, as recited above, at least claim 1 of the present application stands rejected based on a conclusory statement of inherency, rather than upon a "basis in fact and/or technical reasoning." Accordingly, the Applicant respectfully submits that, absent a "basis in fact and/or technical reasoning" for the rejection of record, that rejection of claims 1, 13, 19, and 23 should be reconsidered and withdrawn.

2. Neumann Does Not Disclose or Suggest the Limitations of

Claim 1

Additionally with regard to the rejection of independent claim 1 under 102(e), the Applicant submits that Neumann does not disclose or suggest at least the limitation of "one or both of said first baseband co-processor and said host baseband processor enabling switching between bearers utilizing said low-level stack operations and said set of protocol stack operations and maintaining bearer connections during said switching," as recited by the Applicant in independent claim 1. The Office Action states the following:

one or both of said first baseband co-processor and said host baseband processor enabling switching between bearers utilizing low-level stack operations and set of protocol stack operations and

maintaining bearer connections during switching (figures 2-8B, and paragraphs 6, and 0019-0021, "the master baseband processor is adapted to select the first mode or second mode and control a plurality of shared interface functions").

See the Office Action at pages 3-4. The Applicant points out that the Examiner previously stated the following in the 09/08/2006 Final Office Action:

The combination of Neumann/Schmidt/Kransmo does not specifically disclose one or both of said first baseband co-processor and said host baseband processor enabling switching between bearers utilizing low-level stack operations and set of protocol stack operations and maintaining bearer connections during switching.

See the 09/08/2006 Final Office Action at page 4. In other words, the Examiner has already conceded that Neumann does not disclose the limitation of "one or both of said first baseband co-processor and said host baseband processor enabling switching between bearers utilizing said low-level stack operations and said set of protocol stack operations and maintaining bearer connections during said switching," as recited by the Applicant in independent claim 1.

Furthermore, the Applicant has reviewed Figures 2-8B and paragraphs 0006 and 0019-0021 of Neumann, where Neumann discloses that "the master baseband processor is adapted to select the first mode or second mode and control a plurality of shared interface functions." However, even though Neumann discloses that "the master baseband processor is adapted to select the first mode

or second mode and control a plurality of shared interface functions," Neumann does not disclose or suggest that any switching is performed between the bearers, utilizing low level stack operations and maintaining bearer connections during the switching.

Accordingly, independent claim 1 is not anticipated by Neumann and is allowable. Independent claims 13, 19 and 23 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 13, 19 and 23 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2, 5-7, 14, 17-18, 20-22 and 24-26

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 13, 19 and 23 under 35 U.S.C. § 102(e) as being anticipated by Neumann has been overcome and requests that the rejection be withdrawn. Additionally, claims 2 and 5-7, 14, 17-18 and 20-22, and 24-26 depend from independent claims 1, 13, 19 and 23, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2, 5-7, 14, 17-18, 20-22 and 24-26.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion..., citing *AI-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima*

facie case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

II. The Proposed Combination of Neumann and Schmidt Does Not Render Claims 3-4, 12 and 15-16 Unpatentable

Claims 3-4 and 12, and 15-16 depend from independent claims 1 and 13, respectively, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 3-4, 12 and 15-16.

III. Allowable Subject Matter

The Applicant thanks the Examiner for allowing claims 27 and 28. The Applicant points out that new claim 29 includes all of the limitations of claim 1 and claim 8. Furthermore, new claim 30 includes all of the limitations of claim 1 and claims 8-9. Since claims 8-9 were objected to in the Office Action, the Applicant

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submits that new claims 29-30 are allowable. The Applicant has cancelled the objected to claims 8-11.

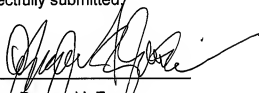
CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-7 and 12-30 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,



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Date: 26-MAR-2007

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